

Honeywell's Docket No. 30-4333 US - 4780  
Practitioner's Docket No. H9930-4505

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hacker, et al.

Application No.: 10/520,252                      Group No.: Not Yet Assigned  
Filed: August 15, 2002                      Examiner: Not Yet Assigned  
For: Nanoporous Materials and Methods of Formation Thereof

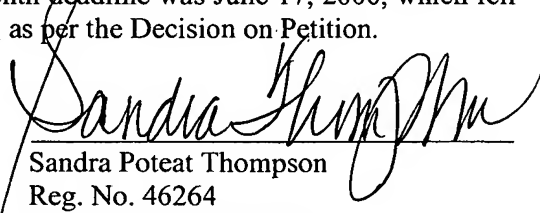
Mail Stop PCT  
Commissioner for Patents  
Office of PCT Legal Administration  
PO Box 1450  
Alexandria, VA 22313-1450

RENEWED PETITION UNDER 37 C.F.R. 1.47

This petition is being filed as a Response to the Decision on Petition mailed January 17, 2006. Enclosed is a copy of the Renewed Petition Under 37 CFR 1.47(a), a copy of the Decision on the original Petition, all Declarations for Patent Application for all inventors and a Change of Correspondence Address Form, which should be entered immediately.

Please charge Account No. 500977 for extension fees for 3 months (\$1020.00) given that the due date for a response was March 17, 2006 and the 5-month deadline was June 17, 2006, which fell on a Saturday. There should be no additional petition fees, as per the Decision on Petition.

Date: June 19, 2006

  
Sandra Poteat Thompson  
Reg. No. 46264  
BUCHALTER NEMER

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. SECTION 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

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☒ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, Alexandria, VA, 22313-1450.

Date: June 19, 2006

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Colleen K. Houston

RECEIVED  
13 JUL 2006  
Legal Staff  
International Division

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: **Hacker et al.**

Serial No: **10/520,252**

Filed: **August 15, 2002**

For: **NANOPOROUS MATERIALS  
AND METHODS OF  
FORMATION THEREOF**

Examiner: **Not Assigned Yet**

Art Unit: **Not Assigned Yet**

**CHANGE OF ADDRESS**

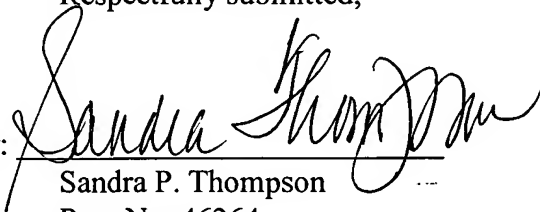
Dear Sir:

Please record the mailing address of the attorney handling this matter as follows:

Sandra Poteat Thompson  
Buchalter Nemer, A Professional Law Corporation  
18400 Von Karman, Suite 800  
Irvine, CA 92612  
Phone: 949-224-6282  
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E-mail: [sthompson@buchalter.com](mailto:sthompson@buchalter.com)  
USPTO Reg. No. 46264  
Customer Number: 000062993

Respectfully submitted,

Dated: June 19, 2006

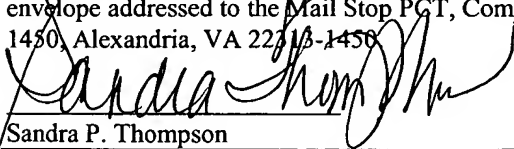
By:   
Sandra P. Thompson  
Reg. No. 46264  
Attorneys for Applicant(s)

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CERTIFICATE OF MAILING (37 CFR 1.8a)

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail with sufficient postage, in an envelope addressed to the Mail Stop PGT, Commissioner of Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22303-1450.

  
Sandra P. Thompson

Dated: June 19, 2006

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor: **Hacker et al.**

Serial No: **10/520,252**

Filed: **August 15, 2002**

For: **NANOPOROUS MATERIALS  
AND METHODS OF  
FORMATION THEREOF**

Examiner: **Not Assigned Yet**

Art Unit: **Not Assigned Yet**

**RENEWED PETITION UNDER 37 CFR 1.47(A)**

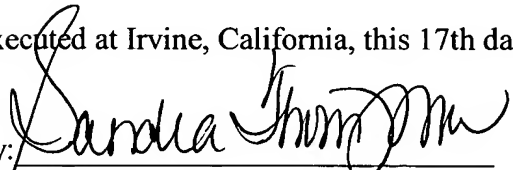
I, the undersigned, Sandra Poteat Thompson, hereby respectfully file a renewed petition under 37 CFR 1.47(a) and state the following:

1. I am the attorney of record for Honeywell International Inc., and am an attorney with the firm of Buchalter Nemer, A Professional Corporation.
2. I reviewed the decision on the petition in detail and provide the following statements regarding the decision.
3. The issue regarding inventor Scott Lefferts is herein mooted by the attached signed Declaration for Patent Application. I respectfully request that the Petitions Attorney review this document and reconsider his position on the signature of Mr. Lefferts.
4. The issue regarding the declaration filed on September 6, 2005 is also easily rectified. I declare that the inventors were presented with a complete declaration for signing. I also declare that I compiled the declaration into one single document filed on September 6, 2005. Please find attached the full copies of those complete declarations for each of the inventors of the above-referenced application that comply with 37 CFR 1.47 (a) and (b).

5. I hereby declare that all statements made herein of my own knowledge are true and that statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18, United States Code, Section 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed at Irvine, California, this 17th day of June, 06.

By:

  
Sandra Poteat Thompson, PhD  
Registration Number: 46,264

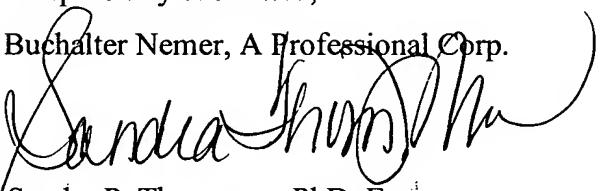
Dated:

6/19/2006

Respectfully submitted,

Buchalter Nemer, A Professional Corp.

By:

  
Sandra P. Thompson, PhD, Esq.  
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E-mail: [sthompson@buchalter.com](mailto:sthompson@buchalter.com)  
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ATTORNEYS FOR APPLICANT(S):

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17 JAN 2006

Bingham McCutchen LLP  
Three Embarcadero Center  
18th Floor  
San Francisco, CA 94111-4067

**RECEIVED**

JAN 23 2006

Bingham McCutchen  
IP Docket Dept.

In re Application of :  
HACKER et al. :  
U.S. Application No. 10/520,252 :  
PCT No.: PCT/US02/26276 :  
It. Filing Date: 15 August 2002 :  
Priority Date: None :  
Attorney Docket No.: 7210332001-3221000 :  
For: NANOPOROUS MATERIALS AND :  
METHODS OF FORMATION THEREOF :

**DECISION ON PETITION**

This decision is in response to "Petition under 37 CFR 1.47(a)" filed 06 September 2005 to accept the application without the signature of joint inventor, Scott Lefferts.

**BACKGROUND**

On 15 August 2002, applicants filed international application PCT/US02/26276 which claimed no priority date. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the international filing date, 15 February 2005.

On 03 January 2005 applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 25 July 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 06 September 2005, applicants filed a petition under 37 CFR 1.47(a).

**DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or

Docket: 721033-2001

Action: TRANS. TO S. THOMPSON

Date Due:

her own behalf and behalf of the nonsigning joint inventor. Items (1) and (3) have been satisfied.

As to item (2), petitioner states that Scott Lefferts cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

A review of the present petition reveals that the petitioner has not provided an acceptable showing that a diligent effort was made to locate the nonsigning inventor, Scott Lefferts. Petitioner states that "[i]nventor Scott Lefferts is no longer employed by Honeywell. . . We are taking the fact that he has been non-responsive to our correspondence as his refusal to sign the declaration/power of attorney." However, no documentary evidence to support the failed attempts were provided with the present petition.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Scott Lefferts, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

As to Item (4), a review of the declaration filed on 06 September 2005 reveals that declaration is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The declaration filed with the petition includes duplicate sheets. It is unclear if the inventors were presented with only their signature page, in which case the execution would be improper, or if they were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into

the single document filed 06 September 2005, which is improper. (See MPEP 201.03, Page 200-7) Therefore, in order to satisfy this item, applicants are required to file declaration(s) which comply with 37 CFR 1.497(a) and (b).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Scott Lefferts under 37 CFR 1.47(a) at this time.

### CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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